



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,284	10/27/1999	ANDREW D. HOLMES	3894	4449
758	7590	02/27/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/428,284	HOLMES ET AL.
	<b>Examiner</b> Timothy M. Harbeck	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Statys

1)  Responsive to communication(s) filed on 05 December 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-20,22,24-33,35-50,52-54 and 56 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20,22,24-33,35-50,52-54 and 56 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

In view of the Appeal Brief filed on December 5, 2005, PROSECUTION IS HEREBY REOPENED. The new grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 22, 24-33, 35-50, 52-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over NEMZOW (US 2001/0011241).

**Re Claim 1:** NEMZOW discloses a computer-implemented system for managing financial transactions, a method for applying an exchange rate to convert a transaction from a first currency to a second currency, comprising:

receiving, by a computer system, a financial transaction, including a date and a transaction amount in the first currency (100),

accessing, by the computer system, an electronically stored plurality of historical exchange rates for the first currency with respect to the second currency, each exchange rate corresponding to a time period (110; paragraph (0050)),

automatically applying, by the computer system, the selected historical exchange rate to the received financial transaction, to derive a converted transaction amount in the second currency (120,130); and

performing at least one of the steps of storing the converted transaction amount in a storage medium; and

outputting the converted transaction amount (150; paragraph 0049-0061);

Nemzow does not explicitly disclose the steps of:

if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates; automatically selecting, by the computer system, the historical exchange rate;

if the date of the received financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting, by the computer

system, a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

**Re Claim 2:** Nemzow discloses the claimed method *supra* and further discloses wherein each time period comprises one selected from the group consisting of:

- A date; and
- A range of dates (Page 3, paragraph 0046)

**Re Claim 3:** Nemzow discloses the claimed method and further discloses storing the received financial transaction including the date, the transaction amount, and the selected exchange rate (Page 3, paragraphs 0043 “inputs that define the transaction;” paragraph 0044 “the user inputs are stored”).

**Re Claim 4:** Nemzow discloses the claimed method *supra* but does not explicitly disclose receiving input overriding the selected exchange rate, the input comprising a second exchange rate. However, Nemzow notes that conversion rules are specified from a number of sources including immediate user input (Paragraph 0050-0051). It therefore would have been obvious to anyone skilled in the ordinary art at the time of invention to use the Nemzow system to receive input overriding the selected exchange rate, since the system of Nemzow is designed to be customizable to any conversion configuration. While not disclosing every possible input or rule associated with currency exchanges, the broad language and Nemzow’s explicit statement that “the user specifications are not limited to those listed here,” indicate that the open structure of the invention is meant to encompass as many scenarios as possible.

**Re Claim 5:** Nemzow discloses the claimed method and further discloses the step of storing, in the stored plurality of exchange rates, the second exchange rate and a corresponding time period for the second exchange rate (Paragraph 0050 “taking user input for conversion rules and rates.”)

**Re Claim 6:** Nemzow discloses the claimed method *supra* and further discloses the step wherein the financial transaction is a transfer between accounts (Paragraph

0003; “translate between the currencies of a sender of a product and a receiver.” This is a transfer between the respective parties accounts.)

**Re Claim 7:** Nemzow discloses the claimed method supra and further discloses the step wherein the financial transaction is selected from the group consisting of an investment purchase and an investment sale (paragraph 0025)

**Re Claim 8:** Nemzow discloses the claimed method supra and further discloses the step wherein outputting the converted transaction amount comprises generating a report including the converted transaction amount (paragraph 0064) and outputting the generated report (0054).

**Re Claim 9:** Nemzow discloses the claimed method supra and while not explicitly disclosing wherein the report is selected from the group of a capital gains report, a transaction report and an investment report, these types of reports are notoriously well known in the art and would have been obvious to anyone of ordinary skill so that they could see the output of the transaction in a variety of different formats that can help them evaluate the current transaction and plan for future ones.

**Re Claim 10:** Newzow discloses all the claimed features similar to claim 1 above, and while not explicitly disclosing the step wherein the computer system handles a plurality of transactions, the step was old and well known in the art and would have been obvious to anyone of ordinary skill. A computer system as disclosed by Nemzow with a processor and a database can accept more than one transaction for storage so that the system is not delayed every time one transaction is being processed. The

system would contain a queue of pending transactions so that users could easily and efficiently enter inputs without having delay.

**Re Claims 11-14:** Further method claims would have been obvious from previously rejected claims 6-9 and are therefore rejected using the same art and rationale.

**Re Claim 15:** Nemzow discloses a method for generating a financial report including at least two transactions comprising

- Retrieving, by a computer system, a first transaction including a first date, a first transaction amount in a first currency, and a first historical exchange rate for the first currency responsive to the first date (paragraphs 0046-0047; “transaction rules including the dates and time defining the transaction or transactions”)
- Retrieving, by the computer system, a second transaction including a second date, a second transaction amount in a second currency, and a second historical exchange rate for the second currency responsive to the second date (paragraphs 0046-0047; “data having multiple entries with various associated times and bases, in relation to a plurality of other currencies could be stored;” and “transaction rules including dates and time defining the transaction or transactions” indicates multiple currencies and multiple transactions)

While not explicitly disclosing the step of automatically applying the first historical exchange rate to the first transaction and the second historical exchange rate to the

second transaction to produce the respective converted amount in a home currency, Nemzow notes that the conversion rules are specified by the user and therefore, if a user wanted to implement the above steps it could easily have been done using these rules (paragraphs 0050-0051). It is the examiners assertion that any exchange involving a currency translation could be implemented using these rules since the system stores a plurality of currency rates respective to time (0046). Further more the user describes the targeted currency rate and may also list a base (home currency) which would be the default. An output involving both transaction would also be obvious to anyone skilled in the ordinary art at the time of invention as a way to compare the first and second currencies and possibly derive a relationship therefrom if such a relationship is not presently recognized by the system.

Nemzow does not explicitly disclose the steps of:

if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates; automatically selecting, by the computer system, the historical exchange rate;

if the date of the received financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting, by the computer system, a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the

conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

**Re Claim 16:** Nemzow discloses the claimed method *supra* and while not explicitly disclosing wherein the first currency is the same as the second currency, since the user of the system is responsible for inputting this information (paragraph 0043 and 0047), it would be obvious to anyone skilled in the art to perform this step in the Nemzow system if they so desired.

**Re Claim 17:** Nemzow disclose the claimed method and further discloses the step wherein each of the steps of obtaining a first exchange rate and a second exchange rate comprises retrieving an exchange rate from an exchange rate history table responsive to the date of the transaction (paragraph 0046; "currency rates dwould be delivered by the rate data feed, or data having multiple entries with various

associated times and bases, in relation to a plurality of other currencies could be stored.”)

**Re Claim 18:** Further method claim would have been obvious from previously rejected claim 9 and is therefore rejected using the same art and rationale.

**Re Claim 19:** Nemzow discloses a software product for managing financial transactions comprising:

- An exchange rate table for storing a plurality of historical exchange rates for a currency, each historical exchange rate corresponding to a time period (paragraph 0046)
- A user interface comprising a display of historical exchange rate information, the information comprising a plurality of exchange rates obtained from the exchange rate table (paragraphs 0042-0044);
- An exchange rate code module for causing a computer system to perform the steps of: automatically selecting a historical exchange rate from the exchange rate table (paragraph 0043 “translates the original currency value, according to these inputs and also stored conversion rules.”); and automatically applying the selected historical exchange rate to a transaction to obtain a converted transaction amount (paragraph 0043); and at least one of the steps of storing the converted transaction amount in a storage medium and outputting the converted transaction amount (paragraph 0043; “provides an output in a format as required by the user”)

Nemzow does not explicitly disclose the steps of:

Wherein the transaction has a date and wherein automatically selecting the historical exchange rate comprises:

- if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates; automatically selecting, by the computer system, the historical exchange rate;
- if the date of the received financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting, by the computer system, a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states “the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051).” While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses “if” statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant’s invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of

the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

**Re Claim 20:** Nemzow discloses the claimed software product *supra* and further discloses wherein each time period comprises one selected from the group consisting of:

- A date; and
- A range of dates (Page 3, paragraph 0046)

**Re Claim 22:** Nemzow discloses a computer-implemented system for managing financial transactions, a user interface for applying exchange rates to financial transactions, comprising:

- A first user interface element for receiving user entry of a financial transaction including a date (page 0043; accepts a plurality of inputs that define a transaction)

Nemzow does not explicitly disclose

- A second user interface element for displaying, by a computer system, a default value for an exchange rate, the default value corresponding to one selected from the group consisting of
  - A historical exchange rate having a time period corresponding to the date of the financial transaction and
  - A historical exchange rate having a time period that is most recent among available historical exchange rates having time periods prior to the date of the financial transaction

However Nemzow does allow the user a great deal of freedom in terms of setting conversion rules, including the conversion rates and rules for determining these rates (paragraph 0050). Therefore it would have been obvious to anyone skilled in the ordinary art at the time of invention to simply make these rules to the aforementioned specifications if they so choose. Furthermore it would have been obvious to anyone skilled in the ordinary art to use the most recent historical exchange rate if the exact date is not available because this is the most accurate measurement you would have. It would not make sense to use an earlier recorded rate because more time has surpassed and more variables are involved than with the most recent recording. Nemzow also discloses retrieving by the computer system, at least one of user entry of and user selection of an exchange rate for the financial transaction (paragraph 0049, immediate user input).

**Re Claim 24:** Nemzow discloses a computer-implemented system for applying multiple exchange rates comprising:

- A list of currencies (paragraph 0044)
- For each currency, a list of historical exchange rates, each exchange rate corresponding to a time period (paragraph 0046)
- A transaction register for storing transaction records, each of at least a subset of the transaction records (paragraph 0042; user inputs are transactions)
- A transaction input interface for receiving user entry of at least one transaction for storage in the transaction register, each transaction having

a date (paragraph 0047; accepts inputs of data from the user...including dates and times defining the transaction)

Nemzow does not explicitly disclose an exchange rate selector for automatically selecting for at least a subset of the entered transactions, an exchange rate from the list of historical exchange rates by:

- if the date of the entered transaction corresponds to a time period of one of the historical exchange rates; automatically selecting the historical exchange rate;
- if the date of the entered financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could

achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

Nemzow further discloses wherein the transaction input interface displays the selected exchange rate (paragraph 0043; output in the format as required); and wherein the transaction register stores the selected exchange rate in the corresponding transaction record (0045; These elements are stored in the various records in the database)

**Re Claim 25:** Nemzow discloses the claimed system and further discloses a report generator, coupled to the transaction register, for generating a report including at least one transaction report the report including the exchange rate of the transaction record (0043, currency converter system provides an output in a format as required by the user).

**Re Claim 26:** Nemzow discloses a computer-implemented system for applying multiple exchange rates comprising:

- an exchange rate storage device for storing a plurality of historical exchange rates for converting a first currency to a second currency, each exchange rate corresponding to a time period (paragraph 0046)
- a transaction storage device for electronically storing at least one financial transaction in the first currency, including a date (paragraph 0047)

Nemzow does not explicitly disclose an exchange rate selector, coupled to the exchange rate storage device for automatically selecting for at least one stored financial transaction, an exchange rate from the plurality of historical exchange rates by:

- if the date of the entered transaction corresponds to a time period of one of the historical exchange rates; automatically selecting the historical exchange rate;
- if the date of the entered financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.
- A transaction display, coupled to the transaction storage device and to the exchange rate selector for automatically applying the selected stored exchange rate to the at least one stored financial transaction to obtain at least one value in the second currency, and for displaying the at least one value.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion

and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within. Further more it would have been obvious to anyone skilled in the ordinary art at the time of invention to include a transaction display for displaying the at least one value so that the user can see the output of the system and the results of the currency transaction.

**Re Claim 27:** Nemzow discloses the claimed system and further discloses wherein the transaction storage device stores the financial transaction including the applied exchange rate (paragraph 0044).

**Re Claim 28:** Nemzow discloses the claimed system and further discloses a report generator, coupled to the transaction storage device, for generating a report including the financial transaction in the second currency (Paragraphs 042-043).

**Re Claim 29:** Further system claim would have been obvious in order to perform previously rejected method claim 1 and is therefore rejected using the same art and rationale.

**Re Claim 30:** Nemzow discloses the claimed system and further discloses an exchange rate table, coupled to the exchange rate retrieval device, for storing the obtained exchange rate and the date (paragraph 0046).

**Re Claim 31:** Nemzow discloses the claimed system and further discloses a report generator, coupled to the transaction storage device, for generating a report including the financial transaction (paragraph 0043 "output in a format as required by the user.")

**Re Claim 32:** Further system claim would have been obvious to perform previously rejected method claim 15 and is therefore rejected using the same art and rationale.

**Re Claim 33:** Nemzow discloses the claimed system and further discloses a transaction storage device for storing at least two financial transactions and an associated exchange rate for each financial transaction (paragraph 0044).

**Re Claim 35-50, 52-54 and 56:** Further computer program product claims would have been obvious in order to implement the previously rejected method claims 1-16, 18-20 and 22, respectively, and are therefore rejected using the same art and rationale.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-20, 22, 24-33, 35-50, 52-54 and 56 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\*



HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600